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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,319	09/29/2000	Ernie F. Brickell	10559/329001/P9832	1992
20985	7590	07/28/2005		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER HENNING, MATTHEW T	
			ART UNIT	PAPER NUMBER
			2131	
DATE MAILED: 07/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/676,319

Applicant(s)

BRICKELL ET AL.

Examiner

Matthew T. Henning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 42-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-65 is/are rejected.
- 7) ☒ Claim(s) 42 and 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1 This action is in response to the communication filed on 5/25/2005.

2 ***Continued Examination Under 37 CFR 1.114***

3 A request for continued examination under 37 CFR 1.114, including the fee set forth in  
4 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is  
5 eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)  
6 has been timely paid, the finality of the previous Office action has been withdrawn pursuant to  
7 37 CFR 1.114. Applicant's submission filed on 5/25/2005 has been entered.

8 **DETAILED ACTION**

9 Claims 1-41 have been cancelled and new claims 42-65 have been examined.

10 All objections and rejections not specifically addressed below have been withdrawn.

11 ***Response to Arguments***

12 Applicant's arguments with respect to French have been considered but are moot in view  
13 of the new ground(s) of rejection.

14 ***Claim Objections***

15 Claims 42, and 50 are objected to because of the following informalities:

16 Claims 42 and 50 recite the limitation "at an authentication service" which is not  
17 grammatically correct.

18 Appropriate correction is required.

19 ***Claim Rejections - 35 USC § 112***

20 The following is a quotation of the second paragraph of 35 U.S.C. 112:

21 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the  
22 subject matter which the applicant regards as his invention.  
23

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1 Claims 44-45, are 52-53 rejected under 35 U.S.C. 112, second paragraph, as being  
2 indefinite for failing to particularly point out and distinctly claim the subject matter which  
3 applicant regards as the invention.

4 These claims all recite the limitation "and further comprising". It is unclear exactly what  
5 is further comprising as both the method and the authentication information are referred to in the  
6 claims. As such, one of ordinary skill in the art would not be able to determine the scope of the  
7 claim. Therefore, claims 44-45 and 52-53 are rejected for failing to particularly point out and  
8 distinctly claim the subject matter which the applicants regard as the invention.

9 ***Claim Rejections - 35 USC § 103***

10 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
11 obviousness rejections set forth in this Office action:

12 *A patent may not be obtained though the invention is not identically disclosed or*  
13 *described as set forth in section 102 of this title, if the differences between the subject*  
14 *matter sought to be patented and the prior art are such that the subject matter as a*  
15 *whole would have been obvious at the time the invention was made to a person having*  
16 *ordinary skill in the art to which said subject matter pertains. Patentability shall not be*  
17 *negated by the manner in which the invention was made.*  
18

19 Claims 42-43, 46, 48-51, 54, 56-59, 62, and 64-65 are rejected under 35 U.S.C. 103(a) as  
20 being unpatentable over Sheehan et al. (US Patent Number 6,311,163) hereinafter referred to as  
21 Sheehan, and further in view of Saito et al. (US Patent Number 6,275,941) hereinafter referred to  
22 as Saito.

23 Regarding claims 42, 50 and 58, Sheehan disclosed a system, method, and software for a  
24 prescribing party to issue a prescription through a communication network such as the Internet,  
25 in which the prescribing party includes doctors, health service providers, and other authorized  
26 personnel (See Sheehan Abstract and Col. 3 Lines 45-57, Col. 4 Lines 47-49, and Fig. 4 ).

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1 However, Sheehan failed to disclose a method for ensuring that the prescribing party was in fact  
2 authorized to issue prescriptions.

3 Saito teaches a system for authenticating a user (See Saito Fig. 5 and Col. 7 Lines 5-55)  
4 involving storing authentication information for a plurality of users (See Saito Col. 7 Lines 25-26  
5 wherein the public keys of users must have been stored in order for them to be accessed by the  
6 authentication server); at an authentication service (authentication server), receiving digital  
7 credential information (integrated certificate) associated with a first user (client) from a relying  
8 party (application server) (See Saito Col. 7 Lines 21-24); verifying the digital credential  
9 information associated with the first user to the relying party (See Saito Col. 7 Lines 25-36);  
10 providing verification information associated with the first user to the relying party (See Saito  
11 Col. 7 Lines 36-52); and providing information to the first user, the information indicative of  
12 receiving the digital credential information associated with the first user from the relying party  
13 (See Saito Col. 7 Lines 57-63). Saito further teaches providing information to the first user  
14 comprises providing access to an activity log associated with the first user (See Saito Col. 8  
15 Lines 3-5 and 36-44).

16 It would have been obvious to the ordinary person skilled in the art at the time of  
17 invention to employ the teachings of Saito in the prescription issuing system of Sheehan by  
18 having the prescribing doctor send an integrated certificate to the server, and having the server  
19 authenticate the certificate and doctor via an authentication server. This would have been  
20 obvious because the ordinary person skilled in the art would have been motivated to ensure that  
21 only authorized doctors were issuing prescriptions.

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1           Regarding claims 43, 51, and 59, the combination of Sheehan and Saito disclosed  
2     providing access to an activity log associated with the first user (See Saito Col. 8 Lines 3-5 and  
3     36-44).

4           Regarding claims 46, 54, and 62, the combination of Sheehan and Saito disclosed storing  
5     access information associated with the relying party, the access information including  
6     information indicative of the providing the verification information associated with the first user  
7     (See Saito Col. 7 Lines 44-52); and providing the access information to the relying party (See  
8     Saito Col. 7 Lines 44-52).

9           Regarding claims 48, 56, and 64, the combination of Sheehan and Saito disclosed that  
10    providing verification information to the relying party comprises providing information  
11    indicative of a failure to authenticate the digital credential information associated with the first  
12    user (See Saito Col. 7 Lines 36-38).

13          Regarding claims 49, 57, and 69, the combination of Sheehan and Saito disclosed at least  
14    one of the relying party and the authentication service issuing a challenge in response to  
15    receiving digital credential information associated with the first user (See Saito Col. 7 Lines 21-  
16    24).

17          Claims 44-45, 47, 52-53, 55, 60-61, and 63 are rejected under 35 U.S.C. 103(a) as being  
18    unpatentable over the combination of Sheehan and Saito as applied to claims 42, 50, and 58  
19    above, and further in view of State of Colorado (Senate Bill 97134 LLS NO. 970530.01)  
20    hereinafter referred to as Colorado.

21          The combination of Sheehan and Saito disclosed an authentication server verifying an  
22    integrated certificate of a doctor and sending the result to the prescription server prior to

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1 allowing prescriptions to be issued (See the rejection of claim 42 above), but failed to disclose  
2 verifying registration information with a registration authority.

3 Colorado teaches that in order to write a prescription in the state of Colorado, an  
4 advanced practice nurse must be listed on the advanced practice registry, have a license in good  
5 standing without disciplinary sanctions, and have fulfilled requirements established by the board  
6 (See Colorado Section 7).

7 It would have been obvious to the ordinary person skilled in the art at the time of  
8 invention to employ the teachings of Colorado in the prescribing party authorization system of  
9 Sheehan and Saito by checking the standing of the medical license of the party, whether they are  
10 registered on the advance practice registry, and the status of fulfillment of the requirements  
11 established by the board. This would have been obvious because the ordinary person skilled in  
12 the art would have been motivated to ensure that all legal requirements for issuing prescriptions  
13 were fulfilled prior to authorizing the party to issue prescriptions.

14 *Conclusion*

15 Claims 42-65 have been rejected.

16 The prior art made of record and not relied upon is considered pertinent to applicant's  
17 disclosure:

18 Houvener (US Patent Number 6,424,249) disclosed a credit card authentication server  
19 which authenticated a credit card and sent the result to a relying party.

20 De La Hueraga (US Patent Number 6,408,330) disclosed a prescription/medical  
21 authentication system which informed the prescribing doctor when a prescription had been filled.

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1 Muftic (US Patent Number 5,943,423) disclosed a system in which a doctor digitally  
2 signs a digital prescription and the pharmacy checks the signature prior to filling the prescription.

3 Any inquiry concerning this communication or earlier communications from the  
4 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.

5 The examiner can normally be reached on M-F 8-4.

6 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
7 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the  
8 organization where this application or proceeding is assigned is 571-273-8300.

9 Information regarding the status of an application may be obtained from the Patent  
10 Application Information Retrieval (PAIR) system. Status information for published applications  
11 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished  
12 applications is available through Private PAIR only. For more information about the PAIR  
13 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR  
14 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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17  
18 Matthew Henning  
19 Assistant Examiner  
20 Art Unit 2131  
21 7/13/2005  
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